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To: **Mail Stop Appeal Brief- Patents**
Exam. DANG, Khanh, GAU: 2111
Fax No.: (571) 273-8300
From: George M. Macdonald
Date: September 23, 2005
Subject: Serial No.: 09/801,725
Pages: 6 (including this cover)

Re: U.S. Patent Application Serial No.: 09/801,725
Confirmation No.: 5084
Our Docket # F-906-O1
Old Docket Number: 1591.0050001/RES/RDL

In furtherance of the March 7, 2005 Notice of Appeal in the above referenced case, enclosed please find the Appellants' Reply Brief.

CERTIFICATION OF FACSIMILE TRANSMISSION

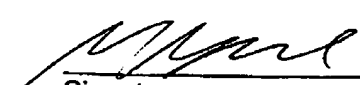
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Patent and Trademark Office
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1. Appellants' Reply Brief on Appeal (5 pages).

on September 23, 2005
Date of Transmission

George M. Macdonald
Name of Registered Rep.
Reg. No.: 39,284


Signature

September 23, 2005
Date

Serial No.: 09/801,725
Attorney Docket No.: F-906-O1

Patent

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:) Attorney Docket No.: F-906-O1
Tim King, et al.) Old Docket: 1591.0050001/RES/RDL
)
) Customer No. 919
)
Serial No.: 09/801,725) Examiner: DANG, Khanh
Filed: March 9, 2001) Group Art Unit: 2111
Confirmation No.: 5084) Date: September 23, 2005

Title: SYSTEM AND METHOD FOR SENDING ELECTRONIC MAIL AND
PARCEL DELIVERY NOTIFICATION USING RECIPIENT'S
IDENTIFICATION INFORMATION

Mail Stop Appeal Brief- Patents
Commissioner for Patents
PO BOX 1450
Alexandria, Virginia 22313-1450

APPELLANTS' REPLY BRIEF ON APPEAL

Sir:

The Appellants respectfully submit this reply brief pursuant to 37 C.F.R. § 1.193(b)(1) in reply to the Examiner's Answer filed on July 25, 2005 in the appeal of the subject application. The Notice of Appeal was filed on March 7, 2005, and the Appellant's Brief was filed on June 7, 2005. No fee is believed Due. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. 16-1885.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, on September 23, 2005 (Date of Transmission).
George M. Macdonald, Reg. No. 39,284 (Name of Registered Rep.)

 (Signature)

September 23, 2005 (Date)

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Rejections Under 35 USC section 112

Initially, it appears that the rejections of claims 1, 4, and 11 under 35 U.S.C. section 112 have been withdrawn. Regarding the remaining rejection of claims 8 and 10, Appellants respectfully submit that the specification clearly teaches one of skill in the art how to send an e-mail using a physical address as described in the opening brief.

Rejections Under 35 USC section 103

Additionally, the rejection of claim 6 has been changed in the Examiner's Answer. Appellants maintain that the claim is patentable over the cited references.

Appellants note that the support for the rejections of claims 2, 3 and 4 were not delineated and readily apparent. Appellants regret the oversight of missing it. However, Appellants respectfully submit that the claims are patentable for at least the reasons stated and have yet to discover an articulated rejection of claim 17.

Furthermore, regarding claims 2 and 3, the Examiner does not suggest that a recipient can request traditional mail delivery in the prior art, but rather that some default failure to act might result in such delivery. Accordingly, for at least the reasons describe with reference to claim 1 and the reason above, Appellants respectfully submit that the rejection be reversed.

Regarding claim 4, Appellants regret the typographical error noted and appreciate its correction. However, the Examiner does not address the claim limitation "using a physical address." Accordingly, for at least the reasons describe with reference to claim 1 and the reason above, Appellants respectfully submit that the rejection be reversed.

Official Notice and Prior Art of Record

Appellants and the undersigned attorney regret any interpretation of the statements in the opening brief as being anything other than a respectful, but strenuous, disagreement with the application of Official Notice as stated in the case. See Examiner's Answer at 19. Appellants have repeatedly challenged several (but not all) of the many instances of official notice requesting documentary support (here renewing

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such request, and if based upon personal knowledge, an affidavit). Appellants do not concede that contemporaneous documentary support is available to show support of Official Notice, but it is arguable, that if such "cited" documentary support is contemporaneous (if it itself is not available as prior art), it must at a minimum establish by a preponderance of evidence that the statement of official notice is unquestionably supportable as being well-known before the date required for the official notice to be effective as prior art in the case. The documentary support provided here does not clearly do so. Furthermore, the so-called references are not available on PAIR as "NPL" references.

Furthermore, it is not clear whether such alleged documentary support is now cited as prior art (for the first time) without sufficient bases. See Examiner's Answer at page 3. Such references were never cited on a PTO-892 and Appellants do not concede that they are available. Similarly, patents listed as prior art are not available against the present application and any application of them is respectfully traversed. For example, the earliest priority dates of Baird III, et al. (6,732,278) and Creswell, et al. (6,775,690) are both after the effective filing date of the present case and not available.

The taking of Official Notice is a device for convenience and not meant to remove the requirement of establishing a prima facie rejection. Appellants are entitled to clearly defined statements of Official Notice. Furthermore, it is further submitted that the claimed elements including "electronic mailbox for each physical address", "interface that allows said recipient to forward an e-mail to said recipient using said physical address", "allowing a user to specify a physical address of a recipient to whom the e-mail is to be sent", "mapping said physical address of said recipient to an e-mail address of said recipient", "physical address of said buyer is used to send said e-mail" and "send an email using a physical address" are significant in that they are clearly points of novelty for which the Examiner is relying solely upon alleged common knowledge as the principal evidence upon which the rejection is based. See claims 1, 3, 4, 5, 8, 10 and 11 respectively. As discussed in *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ 2d 1693, 1697 (Fed. Cir. 2001), such reliance on common knowledge is never appropriate. See also, *In re Lee*, 277 F.3d 1338, 1344-45 (Fed. Cir. 2002).

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As to the statements of Official Notice in the Examiner's Answer, prior reasons for disputing the notices are incorporated by reference:

Page 6, "Mapping a physical address to an email address." This statement of Official Notice is presented for the first time in the Examiner's Answer and not in the Final Rejection at page 4. It is disputed. The alleged documentary support does not support a date of such availability.

Page 8, 11, 16 and 18, "mapping a physical address to an email address; or in other words, searching a recipient's email address using a person's physical address in a data base." This statement of Official Notice is presented for the first time in the Examiner's Answer and not in the Final Rejection at page 4, 6, 8 and 9. It is not properly advanced and it is substantively disputed. The alleged documentary support does not support a date of such availability.

Page 15, "tagging an email as time sensitive". Not disputed. Appellants do not concede that the combination is appropriate and submit that the claim is patentable for at least the prior stated reasons.

Page 15, "biometric data." To the extent that it is only biometric data that is claimed as old and well known, such statement would not be disputed. However, the rejection is unclear. To the extent that Baird is cited, it is not available as prior art. Furthermore, the Examiner has not pointed to anything in it that suggests the more expansive statement that the use of biometric data to access email was old and well known before the effective filing date of the present application. Appellants do not concede that the combination is appropriate and submit that the claim is patentable for at least the prior stated reasons.

Page 17, "sending email notification to a buyer after an on-line purchase is a common practice in e-commerce." To the extent that it is only that statement taken as old and well known, such statement would not be disputed. However, the rejection is unclear. Appellants do not concede that the combination is appropriate and submit that the claim is patentable for at least the prior stated reasons.

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Invitation to read MPEP 2144.03 at Page 19 of the Examiner's Answer

The cases cited above are cited there and as shown there, only "notorious" facts used to "fill the gaps" in dependent claims is appropriate and its use should be rare at final rejection or later. It cannot be used as the principle evidence relied upon and the facts must be capable of unquestionable demonstration as being well-known. Regarding MPEP 2144.03, section C, this is clearly not the situation in which no demand for support has been made. In fact, several demands specifically directed toward the Official Notice have been made and the Official Notice taken here is inappropriate. Appellants respectfully submit that the Examiner's reliance is misplaced.

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-17 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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